

REMARKS/ARGUMENTS

Claims 1-31 are pending in this application. Claims 1, 10, 19 and 25 are independent claims. Claims 4, 13 and 19-31 have been previously withdrawn from consideration.

Claim Rejections – 35 USC § 103(a)

Claims 1-3, 5-12 and 14-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants Admitted Prior Art (AAPA) in view of Cortopassi et al. (“Cortopassi”, U.S. Patent No. 5,974,558). Applicants respectfully traverse this rejection.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As the Patent Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (emphasis added) *In re Oetiker*, 977

F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In rejecting independent Claim 1, the Patent Office has selected portions from two references (i.e., AAPA and Cortopassi) to arrive at the present invention, in which, none of the references supply the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness for independent Claim 1 has not been established. Therefore, independent Claim 1 should be allowed.

Claims 2-3 and 5-9 depend from Claim 1 and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 2-3 and 5-9 should be allowed.

Claims 10-12 and 14-18 were rejected based on the same rationales as applied to Claims 1-3 and 5-9 (Office Action, page 6, lines 5-6). Thus, Claims 10-12 and 14-18 should be allowed since Claims 1-3 and 5-9 are allowable.

Moreover, Claim 5 recites “issuing a request for said first power saving mode to a physical layer of said Serial ATA interface by hardware when said idle time is equal to said first value” (emphasis added). In rejecting Claim 5, the Patent Office has analogized the controller 129 in FIG. 4 of Cortopassi to “hardware” of the present invention. As indicated in Cortopassi, “[t]he system controller 129 manages ... power to the system” (col. 5, lines 37-39) and “[t]he present implementation takes advantage of the several levels of power management supported by the system controller 129” (col. 5, lines 43-45). However, even though Cortopassi discloses the system controller 129 manages power, the system controller 129 of Cortopassi, as hardware, may *not* issue a request to a physical layer as recited in Claim 5 since the request may be issued by software. Thus, Claim 5 includes an element not taught, disclosed, or suggested by AAPA or Cortopassi or in combination. At least based on this reason, Claim 5 should be allowed. Similarly, Claims 8, 14 and 17 should also be allowed.

Further, in rejecting Claim 3, the Patent Office first correctly admitted that "AAPA together with Cortopassi do not disclose wherein said first power saving mode is a Slumber mode". Then, the Patent Office went on to take Official Notice that "it would have been obvious to one of ordinary skill in the art to further modify AAPA together with Cortopassi to change the first power saving mode to the Slumber mode". Applicants respectfully disagree.

As the Patent Office is well aware, Applicants are required to seasonably challenge statements by the Patent Office that are not supported on the record. M.P.E.P. §2144.03. Further, it is noted that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search failed to disclose a reference which would teach or suggest modifying AAPA together with Cortopassi to achieve the present invention wherein said first power saving mode is a Slumber power state. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the present claimed invention. If the Patent Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection of claim 17 under 35 U.S.C. § 103 be withdrawn.

At least based on this reason, Claim 3 should be allowed. Similarly, Claim 12 should also be allowed.

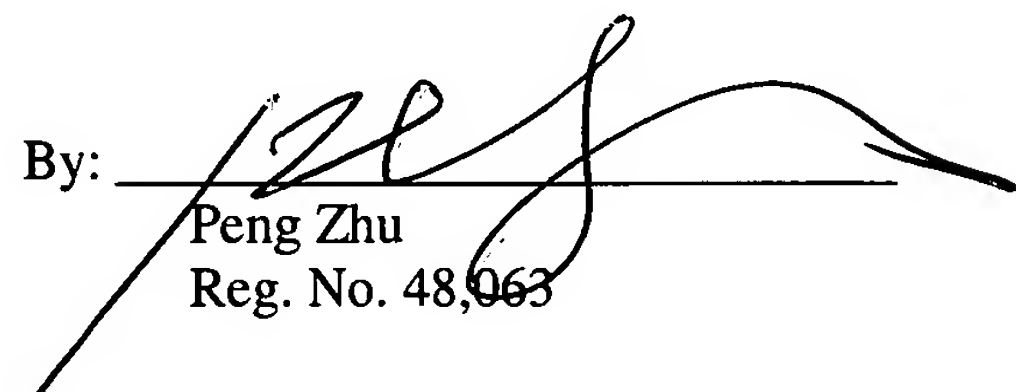
CONCLUSION

In light of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
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By: _____


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